

U.S. CIRCUIT COURT. DISTRICT OF NEW JERSEY.

American Graphophone Company)

vs.

The United States Phonograph)

Co., et al

) In Equity

Defendants' Brief on Motion for Preliminary  
Injunction



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Eben G. Dodge

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Edward D. Easton -

Charles S. Tainter - mail

Emile Berliner

Thomas R. Parvin

Edward Annet - Los Angeles Museum.

Frank L. Cupps

Victor H. Emerson

Fred Wagon

Philip Mauro

James L. Andrews

Calvin G. Childs

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John C. English

Louis P. Valiquet

Orville LaDow

Wm. Baer Owens -

Edward Johnson

Charles A. Cheever -

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United States Circuit Court,

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## Defendants' Brief on Motion for Preliminary Injunction.

It is not proposed in this brief to elaborately discuss all of the many propositions of law and fact bearing upon the situation, but rather to present, as concisely as possible, some of the more pertinent considerations for the determination of the Court.

The patents in suit have never been adjudicated. Suits were, however, brought in February, 1893, against the Edison Phonograph Works in this district and against the Columbia Phonograph Company in the District of Columbia. Both of these suits were at issue in May, 1893, but the *prima facie* case was not concluded in the Columbia case until July last, and that in the Edison Phonograph Works case until November, 1894.

The defendants herein are not, nor have they ever been, engaged in the manufacture of phonographs or parts thereof. Their business, briefly stated, is the purchase and sale of those devices and providing phono-

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graph blanks with musical and other records. For present purposes, it will be sufficient to say that the defendants have purchased their machines and supplies from licensees under the patents in suit, chiefly the New Jersey Phonograph Company and the Kansas Phonograph Company (D. Rec., p. 58, 5d. 229) and that these companies, termed hereinafter "local companies" acquired their rights from the North American Phonograph Company and Jesse H. Lippincott, the exclusive licensees under the patents upon both the graphophone and the phonograph. The complainant concedes the right of the local companies and of these defendants to their phonographs, but contends that although they are entitled to the naked possession of the machines they cannot use them to make a sound record without infringing its patents, inasmuch as the blanks, which they necessarily employ, are (the complainant contends) of recent manufacture and are not covered by the licenses above referred to. This contention proceeds on the assumption that those licenses under which the talking machines now in use were marketed have expired, but *there is not one word in the case before the Court to warrant this assumption.* Of course, the burden of proving the expiration of the licenses is on the complainant. The licenses were set up by defendants as living franchises, and this has not been contradicted by complainant. In their replying affidavit the defendants set up this license, and the fact that the rights of the local companies with whom they deal had been extended under the same until 1903. This was not disputed on the argument. More than that, there was a direct admission as to the present existence of these rights for, during the argument, on consent of defendants' counsel, complainant introduced an affidavit of the vice-president and general manager of the complainant which, while denying other things in the affidavits of Messrs. Tewksbury, Dodge and Emerson, left the subject of the defendants' rights to deal in phonographs and supplies obtained from the local licensed companies *wholly untouched and uncontradicted.*



As to the nature of the proceeding now before the Court. We shall show, later on, that complainant has been guilty of gross laches. In endeavoring to explain away complainant's failure to move for injunction against the Columbia Company, the affidavit of Pollak (one of complainants' counsel) shows (p. 3) that the relations of the parties, *i. e.*, the American Graphophone Co., the Columbia Phonograph Co. (one of the licensed local companies) and the Edison Phonograph Works (the manufacturing company) "were complicated by contracts, creating questions difficult to discuss on a motion for preliminary injunction," therefore no motion for injunction was made and that this contract complexity does not exist in the present case. The fact is that the Columbia Co., so far as concerns its right to deal in phonographs and supplies, is and has been in precisely the same position as the Kansas and New Jersey companies from whom defendants obtain their goods. Complainant shows that it expected the Columbia Company to justify its acts under its license, and that is exactly what defendants do here. That is to say, they justify under the contracts of the New Jersey and Kansas companies, which are practically the same as that under which the Columbia Company operates. The contract complication is therefore the same in both cases, and we agree with complainant's counsel that the complexity of the situation is such that a court of equity cannot reasonably be expected, on motion for preliminary injunction, to straighten out the complication.

With this brief statement of the case we shall proceed to discuss the patents in suit, the relation between them and the defendants' operations, the license under which defendants' vendors are carrying on business and which inures to defendants' benefit, and the law in its application to the case at bar.



### The Patents in Suit.

The patents in suit, although claimed by the complainant to be basic and primary, show in fact very little, if any, advance in the art of recording and reproducing sound. A little history on the subject may be of interest.

In 1877 Mr. Edison gave to the world his great discovery of the phonograph. This discovery, in few words, was that sonorous vibrations, acting upon a sensitive membrane or diaphragm, could be recorded on, and reproduced from, a suitable substance by means of recording and reproducing styles attached to said diaphragm. This discovery was hailed all over the world as marking an epoch in history, and, as with the telephone, the electric light, the dynamo and countless other devices which struck out new paths in electrical and mechanical development, found quantities of devotees, not only in America, but in England and Germany and France. This army of improvers, or adapters, as perhaps they might properly be called, never, for one moment, departed from the track plainly marked by Mr. Edison, but contented themselves in devising unimportant changes in the details of the structure by means of which Mr. Edison's great discovery was carried out, and it is two of these adapters with whom, on this proceeding, we have to deal.

Of course, it would be absurd to contend that the 1877 phonograph was the commercial machine of today. Indeed, there is not in existence even now the ideal apparatus made possible by Mr. Edison's invention. Nevertheless, the underlying principle was there, and the nearest approach to a commercial machine today employs the same elements operating in the same manner, in a broad sense, and performing the same functions and results as did that early, and perhaps crude, device.

The phonograph most widely exhibited at that time was the "tin-foil phonograph," so called, owing to the use of a thin sheet of tin-foil wrapped upon a grooved cylin-



der. It was this device which was widely known as the "Edison Phonograph," for the *desideratum* then was to construct a loud-sounding instrument, capable of use without tubes for conveying the sounds from the diaphragm to the ear. Still, this particular device played but a small part in the discovery of the "talking machine." It was but a single one of many methods devised by Mr. Edison for recording and reproducing sounds. Thus, in 1877 and 1878, instead of impressing the sound vibrations in a sheet of tin-foil, Mr. Edison used a tablet coated with wax, and similar substances. In his British Patent No. 1644 of 1878 (p. 7, line 26 *et seq.*) Mr. Edison says:

"Paper or other materials may be used, the same being coated with paraffine or other hydrocarbons, waxes, gums or lacs, and the sheet so prepared may itself be indented, or the material—say, paper—may be made to pass through a bath of hot paraffine and thence between scrapers. Thin metal foil is now placed on the material and the sheet passed through rollers which give it a beautiful, smooth surface. The indentation can now be made in the foil, and the paraffine or similar material, and the indenting point does not become clogged with the paraffine in consequence of the intervening foil."

This reference to the use of wax-like material and the clogging of the style by the removal of the substance during the recording operation is explained by Mr. Edison (D. Rec., p. 30, fol. 120).

We are not, however, confined to the operations of Mr. Edison in this connection, for, as appears by his affidavit (D. Rec., p. 31, fol. 123), the wax-like materials for receiving phonographic records were used by others, including Lambrigt, Cros and Carbonel; Lambrigt employing stearine, which is a wax-like material, and Cros and Carbonel employing wax.

Another feature for which complainant claims the merit of novelty is the cutting of the record as contradistinguished from indenting it or displacing the material by moving it to one side or the other of the recording style. The complainant's counsel and its expert in the Columbia case have put this distinction into words,



terming the one a cutting action and the other an indenting action, and the cutting action of the patents in suit is claimed to be due to the peculiar construction of the style.

Mr. Edison's affidavit (D. Rec., p. 30, fol. 120, and p. 31, fol. 123) points out very clearly that, in recording sonorous vibrations on wax or wax-like materials, the material is necessarily cut or removed, and that without reference to the shape of the point of the recording style. There is but a single exception to this, and that is the use of a recording medium of a soft, flexible and viscous material, in which there is great cohesion between the minute particles, and which it is impracticable to cut. Certainly, with the use of hard materials, such as metallic soap, which we shall hereafter refer to, or a wax of greater hardness than that contemplated in the patents in suit, it is immaterial whether the style be of a form such as that illustrated in the patents in suit, or whether the point be blunt, except that the sharp points require less power to work them.

In the soft and viscous material the cohesion between the minute particles is so great that the style, in forming the groove therein, instead of making a clean cut, tears the material, so as to leave the groove itself, and more particularly the edges thereof, and the surface of the material adjacent to such groove, coarse and rough. That this is true is evidenced by the fact that the recording blank in use at the present time is of an exceedingly hard material, and it has been found that not only is a cleaner record groove made in this substance, but the integrity of the style is preserved and its useful life prolonged.

For this cutting operation, Mr. Edison used in 1878 various types of sharp recording points, such as chisel-shaped, knife-edged and others (D. Rec., p. 330, fol. 118).

Let us for a moment consider the phonograph of Reynolds, set forth in Patent No. 287,166, granted October 23d, 1883, which Bell & Taintor, in their main



patent, acknowledge as part of the prior art by attempting to distinguish over it both in their description and claims.

*Acrophone*  
Mr. Edison points out (D. Rec., p. 32) that he had disclosed, in 1877, two plans for making phonographic records, first, by causing the vibrations of the diaphragm to move the style directly, and, second, by causing those vibrations to control a greater force which would produce the record. The first of these plans is illustrated in figure 4, and the second in figures 14 and 15 of the British Patent of 1877. Again, figure 50 of the British Patent of 1878 illustrates a construction in which the vibrations of the diaphragm are employed to operate a valve controlling a blast of air which works a second diaphragm carrying the recording style. Mr. Edison says (D. Rec., p. 33, fol. 129):

"Hence, before this patent of Reynolds, not only had metals, waxes and other materials been suggested as the recording surface, but it had also been suggested that the sound vibrations could be used to produce the record directly or to control more energetic means for producing that record."

Reynolds worked upon the second theory and devised a phonograph in which the solid recording material was moved toward and from a rotary cutter which cut the sound record in that material. The patents in suit, to use Mr. Edison's language, "simply adopt the other old method of recording, namely, the operation of the recording style directly by the diaphragm, and apply that to the cutting of one of the old materials already known for the purpose." Mr. Edison adds: "The distinction which the first of the two patents in suit attempts to draw over this Reynolds Patent are not, it seems to me, valid distinctions, in view of what I had already disclosed by my patents."

This being a partial exposition of the state of the art prior to the time when Messrs. Bell and Taintor entered the field, it is difficult to determine upon what theory to approach a discussion of the novelty and merit of what they claimed as the broad feature of their improvement.



In the affidavit of Easton, forming part of the moving papers, a number of claims from each of the two patents in suit are recited, and these, the complainant contends, are infringed by the records formed upon phonograph blanks by the defendants.

It would be inexpedient for the purpose of this motion to enter into an elaborate discussion of all the elements of these several claims, especially as on the oral argument complainant's counsel stated the underlying principle of those claims of the patents in suit which are here involved to be "cutting in wax." It is difficult, indeed, to see what novelty there can be in this operation when viewed in the light of Mr. Edison's work in 1877 and 1878 and the several devices of Reynolds, Lambrigot, Cros and Carbonel. Certainly the use of wax in this connection was old.

As to cutting in that material, this is a distinction without a difference. If, by the indenting process which complainant attributes to Mr. Edison's operations, is meant the process of recording sonorous vibrations in a strip of tin-foil, possibly there is a difference as well as a distinction; but in the instance where a solid resisting material (*i. e.*, wax, etc.) was used, this was undoubtedly "cut" in the sense in which the word is used in the patents in suit.

Anticipating the difficulty of determining just what was meant by the "cutting" action, the patentees have sought to define this word as meaning the removal of the material, and this, as we have shown, was done by Mr. Edison, and described in his English Patent, many years before the graphophone was heard of (D. Rec., p. 30, fol. 120).

To turn to the claims set forth in the affidavit of Easton, it will be seen that in the six claims of Patent No. 341,214 here quoted the changes have been rung upon the cutting in-wax idea just six times.

In the case of the first claim, in order to support patentability the distinction heretofore referred to between cutting and indenting is set forth, but this is the difference between the graphophone and Edison's 1877 tin-foil device; not the difference between the grapho-

phone and the phonograph used by Mr. Edison in 1877 and 1878, in which he employed a solid resisting substance such as the wax like material. In the last clause of the claim a futile attempt is made to differentiate the graphophone from the device of Reynolds, the difference being that in the former case the cutter is vibrated relatively to the recording medium while in the latter case the recording medium is vibrated relatively to the cutter.

The third claim is for a vibratory cutting style, and during all of Mr. Edison's early operations nothing but such a cutting style was used except, possibly, in connection with the tin-foil device. A "knife-edge" recording style is shown in figure 4 of his English Patent of 1877, as the specification of that patent states.

In claim 6, in addition to the cutting style, a tablet or other solid body is specified, together with mechanism for supporting and moving the same with reference to the style. The mechanism specified in this claim is precisely what was used by Mr. Edison in the early days, and is very clearly disclosed in his British Patents. So far as the tablet or other solid body is concerned this we have dealt with heretofore.

The seventh and ninth claims are, the former for cutting in a solid body and the latter for cutting in wax or wax-like composition. These need no further discussion.

Claim 17 is for a sound-record in the form of an irregular groove with sloping walls cut in solid material. The only respect in which this differs from the claims which we have considered is in the sloping walls in the groove, and these, manifestly, depend entirely upon the construction of the recording style. It is quite apparent that, if, as in the mechanisms shown in Edison Patents of 1877 and 1878, a recording style tapering toward the point be used, the groove which it forms in the recording material can have nothing else but sloping walls. There is no possible escape from this conviction, and we shall not, therefore, pursue the subject further.

We next take up for consideration Patent No. 341,-



288, which like No. 341,214, covers a variety of alleged inventions. The claims sued on, however, are directed more particularly to the construction of the recording tablet. Concerning this the patentee says, in his statement of invention at the beginning of the specification:

"First, a new recording tablet is employed. It consists of a hollow cylinder or tube of paper or other suitable material coated with wax or wax-like composition, preferably a compound or mixture of beeswax and paraffine."

The first claim is for a hollow cylinder provided with a wax or wax-like coating; the fourth for a tubular, self-sustaining tablet, and the seventh for certain details of construction which permit of the use of such a tubular tablet.

The theory of invention of the device shown in this patent, certainly so far as concerns the claims quoted in the affidavit of Easton, seems to consist in taking the flat tablet shown in Patent No. 341,214 and making the same tubular. In both cases, as will readily be seen, the recording material, which is the same, is mounted upon a backing of pasteboard or similar material, and the only difference, apparently, is that in the earlier patent the backing is in the form of a flat disk, while in the latter it takes the form of a pasteboard tube.

The seventh claim covers merely the mechanical expedient by means of which the change from a flat to a tubular tablet was made applicable to the graphophone.

It is difficult to conceive any interpretation on which these claims can be sustained, when the prior art, as we have shown, which includes the earlier patent in suit No. 341,214, disclosed the identical substance set forth in this patent, and not only that, but further set forth the method of arranging this so as to bring it into operative relation with the recording mechanism, *i. e.*, by coating it upon a paper foundation. We are not, however, limited to this disclosure, for in the British Patent No. 1644 above referred to, in which Mr. Edison



speaks of the use of paper or other material coated with paraffine or wax, he says (p. 2, line 56 *et seq.*) :

"The phonogram may be in the form of a disk, a sheet, an endless belt, a *cylinder*, a roller, or a belt or strip, and the marks are either in straight lines, spiral, zigzag, or in any other convenient form, so long as the apparatus is adapted to bringing the same into contact with the phonet or speaking part of the apparatus, and the reproduction of the phonogram from a matrix or copy in relief of an ordinary phonogram may be made upon a belt, roller, *cylinder*, plate or other convenient surface."

Thus, even if the change in the form of the tablet arises to the dignity of patentable invention, it was anticipated by Mr. Edison and publicly disclosed.

**The Graphophone patentees did not produce a practicable recording material.**

This is one of the interesting features of the suit at bar. The fact is, that both the patentees and Mr. Edison, in their first operations, made the same vital error. They believed that in order to faithfully record the sonorous vibrations a very soft material must be used. To this end both Mr. Edison and the patentees used precisely the same material. Mr. Edison, it is true, used, in addition, other materials, such as gums and lacs, as well as waxes in an approximately pure state. The difficulty experienced by Mr. Edison with this material is set forth in his affidavit (D. Rec., p. 33, fol. 132). It consisted among other things in the clogging of the style, due to the softness of the material. It is a pertinent fact that this difficulty was also recognized by the patentees of the patents in suit, for in Patent No. 341,288 the machine is provided with a brush, which was designed to prevent this action. A further difficulty was that by reason of the softness and viscosity of the material, it was found impossible to reproduce the hissing and labial sounds. The theory of this, concisely stated, is that although possibly the vibrations might be more or less



faithfully recorded, yet the material has not sufficient stability to withstand the rubbing action of the style of the reproducer in its passage through the groove. The effect of this is that the reproducer readily levels off the elevations and depressions, and this, while objectionable to the reproduction of all sounds, is more peculiarly fatal to certain classes of sonorous vibrations, such as hissing and labial sounds, in which the elevations and depressions in the record groove are almost infinitesimal. These difficulties experienced by Mr. Edison, and his exhaustive experiments directed toward overcoming them, are set forth in his affidavit (D. Rec., p. 34, fol. 136 *et seq.*).

The situation, then, up to a comparatively recent time was that the practicable recording material had not been devised. Mr. Edison had not then brought out his hard blank of metallic soap, and the patentees had a concededly impracticable material. The radical changes in the graphophone and the copying of vital features of the phonograph, including the metallic soap blank, will bear a short discussion.

**The complainant does not employ the construction shown and described in its own patents. On the contrary, it has taken bodily those features of the phonograph which gave the latter success.**

The story contained in the affidavits upon this subject is very instructive as to the extent to which a business concern will go in absorbing successful features of the device of its competitor in order to give his machine the same measure of success. We refer more particularly to Mr. Edison's affidavit (D. Rec., p. 36, fol. 143), the affidavit of Mr. Tewsbury (D. Rec., p. 61, fol. 241, and p. 63, fol. 250), and the affidavit of Mr. Dodge (D. Rec., p. 94 *et seq.*). The facts there set forth may be briefly stated as follows:

Up to a comparatively short time ago the American Graphophone Company, although it had failed to market

the graphophone except to an exceedingly limited extent, had constructed a number of machines, among which were three thousand which had been sold to Jesse H. Lippincott, under his license, these machines having been returned by users and subsequently thrown into scrap at the Edison Phonograph Works (D. Rec., p. 29, fol. 154). In these machines, substantially the construction shown and described in the patents in suit was employed. Of course they varied in some immaterial respects, but the general plan of the device was the same, and substantially the same elements were used as are there described, more particularly in Patent 341,288. The blanks provided with these machines were of the soft and viscous material set forth in the patents, that is, consisting of a thin coating of relatively soft wax upon a pasteboard cylinder. The recording style, as well as the reproducing style, and the diaphragm, were substantial equivalents of those shown in the patents in suit. When, however, the operations of Mr. Edison and the success of his phonograph provided with blanks made not of bees-wax and paraffine, as in the graphophone patents, but of a very hard metallic soap, became known, and the contrast between this machine and the graphophone showed the latter to be so sadly deficient in those vital elements of construction which render these machines useful, the Graphophone Company bodily appropriated those features of the phonograph which gave it precedence.

As set forth at the places in the affidavits just referred to, the Graphophone Company discontinued the use of the pasteboard cylinder coated with soft wax, and commenced employing in its stead the metallic soap cylinders invented by Mr. Edison and manufactured by the Edison Phonograph Works, and these were obtained from the Edison Works through the collusive relations between the American Graphophone Company and the Columbia Phonograph Company, of Washington. The cylinders were obtained by the Columbia Company from the Edison Phonograph Works, and turned over to the American Graphophone Company. What was the result? The graphophone at that time did not have



the other instrumentalities used in the phonograph in connection with the blank of hard metallic soap, and this gave rise to another appropriation of the true cutting style of Mr. Edison's Patents 393,967 and 393,968. This cutting style, constructed of steel or other metal, was subject to surface changes owing to the chemical action of the blank thereon, as well as to changes in the temperature. The graphophone people therefore went further, and by another appropriation, adopted the sapphire recorder of Mr. Edison's Patent 484,583. Later on the phonograph employed a recorder of sapphire, the point of which was hollowed out, this being known in the trade as the "cup-recorder," and at the same time employed a reproducer, the point of which was approximately spherical in form, so as to readily adjust itself to the record groove in its passage there-through. The success of these types of recorders and reproducers led to another appropriation by the Graphophone Company. It thereupon commenced using the cup-recorder and spherical reproducer of Mr. Edison's Patent No. 430,278. These, together with the use in the graphophone of the diaphragm of microscope glass, shown and described in Mr. Edison's Patent No. 400,646, are the organisms referred to by Mr. Dodge in his affidavit as follows (D. Rec., p. 95, fol. 379):

"These Edison recorders and reproducers, used in connection with the hard recording composition first employed by the Edison interests, gave the Graphophone Company the first glimpse of commercial success. Before this time the graphophone was incapable of practical use. Its usefulness increased in proportion as it drew to it those features of the phonograph which had made the latter a business success."

We shall consider hereafter the effect upon an application for special relief by preliminary injunction of a showing that the defendants' apparatus is manufactured under its own patents. It is sufficient at this time to say that defendants' case makes out most clearly and beyond all possible doubt that were it not for Mr. Edison's developments of the phonograph, the Ameri-

can Graphophone Company would be in the same position to day that it occupied at the date of the patents. It would have a machine which at the best would be only a scientific toy, designed to demonstrate certain properties in accoustics, which had been demonstrated by the earliest phonograph of 1877. And this being true, it cannot be said that Bell and Taintor had, by their so-called discoveries, given to the world anything that it did not possess many years prior to their advent.

Having now brought the Court to a position where a bird's-eye view of the general situation can be had, and more especially the position in the art which the operations of the patentees of the patent in suit must assume by reason of the earlier developments of the invention in controversy, it will, perhaps, be expedient to discuss certain propositions upon which defendants contend the injunction motion should be denied.

Of course, as we have intimated heretofore, it is not intended in this brief to discuss this subject exhaustively. The nature of the present proceeding renders such a discussion entirely unnecessary, and we believe we have shown, and will show, that a state of facts exists which makes impossible the relief for which the complainant contends. The discussion of the law can, perhaps, be most logically done under appropriate headings. We therefore present for consideration of the Court the following



**POINTS.**

**1. The complainant is precluded by its laches from relief against these defendants by preliminary injunction.**

The graphophone patents in suit were granted over eight years ago, and this is the first application for a preliminary injunction which has been made during that time, although for many years last past the Edison phonograph has been upon the market and in operation in the hands of users. During the greater portion of this time the complainant and its predecessors have been passive, and beyond making machines which had only an experimental use, did nothing tending to show an assertion on their part of any rights in the device which the complainant now claims as its own.

Two attempts have been made on this motion to explain away this long delay. One of these attempts was made in the affidavit of one of complainant's counsel (Mr. Pollok), whose position is briefly that prior to the failure of the American Graphophone Company's licensee, Lippincott, in May, 1891, arrangements had been made to exploit both the phonograph and the graphophone from the same source, and concurrently, and therefore suit was made unnecessary until that time. This, however, is no explanation of the complainant's supine and passive attitude from May, 1891, down to the present time, nor is it a satisfactory explanation why in the suits brought against the Edison Phonograph Works and the Columbia Phonograph Company in February, 1893, an application was not made for preliminary injunction. Nor does the affidavit referred to attempt to explain away this delay. On the oral argument, however, complainant's counsel realizing the insufficiency of the excuse given in the moving papers, stated that the reason for applying for an injunction first against the United States Phonograph Company was that this company, which did not make any part of its apparatus, but made a specialty of



providing blanks, obtained from the local licenced companies, with musical and other records, was doing the complainant the greatest injury. The insufficiency of this excuse is apparent. It is not a question as to which of various alleged infringers of a patent is doing the complainant most harm, but it is a clear duty on the part of the owner of the patent to assert his rights in that property at the earliest possible moment, not only to the end that he may close out a business which is doing him financial wrong, but also to make an example of that instance of infringement which will warn others who are encouraged by the operations of the earlier infringer to invest large sums and establish large plants for carrying on similar enterprises. The attitude of complainant's counsel at the argument was that neither of the defendants sued in February, 1893, was operating in the same manner as the defendants herein, but this is a matter not shown by the record, and, if we may be permitted to make a similar excursion outside the record our reply is that the attitude of complainant's counsel is based on an error of fact, since the Columbia Company, has for a long period past been carrying on the business of providing Edison phonograph blanks with musical and other records, and that in the very stronghold of the complainant.

What has been the effect of the slothful conduct of the complainant and its predecessors in not asserting until this late date the rights with which they claimed to be vested. The defendants' papers show that a large business has been built up by the defendants, which if the complainant is entitled to relief could have been stopped in its incipency, but which has not only grown up with the knowledge of the complainant, but has been recognized and encouraged by the complainant. Also that the North American Phonograph Company, Edison Phonograph Works and the thirty local companies have continued the business which the complainant contends became an infringing one not later than May,



1891. There has not been, so far as the moving papers show, any assertion on the part of the complainant or its predecessors of any rights adverse to these great interests and enterprises other than the two suits brought in February, 1893, and the actions commenced within the last six weeks. During this whole period the complainant has stood passively by, has seen what it now claims to be its private preserves trampled over by many other persons and concerns, has seen this industry carried on and increased year by year, and, more than that, has even aided in that increase through its encouraging the so-called wrongdoers by dealing with them and accepting their creations, which it has been impossible for them to rival.

The affidavit of Mr. Tewksbury (D. Rec., p. 58, fol. 231 *et seq.*) shows that the American Graphophone Company and the Columbia Phonograph Company are among the best customers of the defendant corporation; that Easton, an officer in both companies, has known of the operations of the defendant company ever since its organization; that the dealings between the complainant and the defendants have been carried on through him, and that never, up to the time when this suit was commenced, has he seriously intimated or suggested that the business carried on by the defendant company was in violation of any rights of the complainant. How can it be said that this attitude of the complainant is consistent with its present application for immediate relief by preliminary injunction? We venture to say that there is not a single case among reported adjudications where a complainant has been granted a preliminary injunction in the face of a showing that he stood by while the so-called infringer was building up the industry which, when it assumed great proportions, he claimed to be in violation of his rights.

The law on this subject is well settled.

"In considering applications for relief by injunction against the infringement of patents, courts of equity require of the patentee due and reasonable diligence in the assertion of his rights, and a long and unreasonable



delay in invoking relief, *or acquiescence for a considerable length of time in the infringement complained of*, may afford sufficient ground for refusing an injunction" (High on Injunctions [3rd Ed.], Sec. 965).

Again, Walker on Patents (2d Ed.), Sec. 684, says :

"Laches is a good defense to a motion for a preliminary injunction, and delay works laches unless it is excused by some fact which renders it reasonable. The delay which, if unexcused, works laches in respect of an application for a preliminary injunction, is that which occurs after the infringement sued upon was committed, and not any delay which occurred before that time. Delay after the infringement may occur before the suit is brought or it may occur after that event and before any motion is made for a preliminary injunction."

If we assume, as is certainly not the case, that the complainant has satisfactorily excused its laches up to the time of the bringing of the suits against the Edison Phonograph Works and the Columbia Phonograph Company, this still leaves a period of nearly two years to be accounted for. While it is difficult to fix any certain period of delay which will form a basis for the contention of laches on the part of complainant, the adjudicated cases show this period to be quite sufficient to oust the complainant. Thus, in *Hockholzer vs. Eager*, 2 Sawyer, 363, a delay of eighteen months, and in *Sperry vs. Ribbons*, 3 B. & A., 261, two years were held sufficient on the ground of complainant's laches to preclude relief by preliminary injunction.

In *Keyes vs. Pueblo Co.*, 31 F. R., 561, on a motion for preliminary injunction, Judge BREWER said, while discussing the subject of special relief by injunction :

"It will often be refused also where there has been great delay on the complainant's part, in consequence of which the defendant has proceeded to build up an industry based upon that patent."

In *Morris vs. Lowell Mfg. Co.*, 3 Fish., 72, Judge LOWELL said :

"Without going to the length of some English cases, and saying that a defendant must be sued very prompt-



ly if a special injunction is to be asked for, I still must think there is much good sense in the general doctrine that one who is known to the patentee to be using his improvement in apparent good faith is entitled to definite and early information of the patentee's construction of his own rights and of his intention to enforce them."

## 2. The Defendants Do Not Infringe.

It is fundamental that the complainant must make out a clear case of infringement. No number of prior adjudications or degree of public acquiescence can relieve the complainant from this duty. And it is sufficient to defeat a motion for preliminary injunction if the infringement is shown to be doubtful. We will first discuss the question of infringement without regard to the claims of the defendants under the licenses on the patents in suit, and will subsequently show how the contention is narrowed by those licenses; and in this discussion we will deal with the two patents separately.

### PATENT NO. 341,214.

This patent may be comprehensively stated as purporting to cover a method and machine for recording speech, wherein the record is cut in a wax or waxlike material, referred to in the claims as "a solid body," a "wax or waxlike composition," and a "compound of beeswax and paraffine." Complainant's counsel at the argument stated that the invention of this patent might be broadly stated as "cutting in wax." The wax or waxlike material which the patent describes is a compound of beeswax and paraffine. The patent also covers the product of the method and machine, viz., a phonograph record cut in wax or waxlike material. And it also covers the tablet or blank upon which the record is to be made, consisting of a paper or pasteboard foundation and a surface coating of beeswax and paraffine compound.

The fact is established by the defendants' affidavits,



and not seriously denied by the complainant, so far, at least, as the record shows, that the cutting of the sound record in the compound of beeswax and paraffine, which the patent describes, was not a success, and that after a long series of experiments directed towards producing a successful result, Mr. Edison made a special discovery which disclosed the reason for prior failures and indicated the path to be pursued to attain success. That discovery was that a relatively soft wax, such as the patents in suit describe, and such as must be employed when the wax is coated upon a paper or paste-board foundation, has not sufficient stability to resist the rubbing action of the reproducing style upon the minute elevations which represent the hissing and labial sounds, and that such sounds are, therefore, not reproduced; and consequently the reproduction is imperfect and unintelligible on account of the omission of essential sounds. Following up that discovery he invented the method of recording sound by cutting the record in metallic soap, which has the hardness and stability requisite to reproduce the hissing and labial sounds, and in connection with this he invented and produced various devices which made the employment of the metallic soap-recording surface a practicable thing. The owners of the patents in suit have recognized and confirmed this situation by adopting Mr. Edison's method of cutting the record in a metallic soap, as well as the various devices which he introduced in that connection. In concluding a review of these facts Mr. Edison states (D. Rec., p. 37, fol. 145):

"While the metallic soap, which is the recording material of the phonograph, is, in a sense, a waxlike material, yet, due to the facts which I have stated, it clearly is not the scientific or practical equivalent of the composition of beeswax and paraffine referred to in the patents in suit."

The defendants employ Mr. Edison's method, material and devices, and do not employ the method, material or devices of the patent in suit.

The claims upon the recording tablet in this patent are limited in all instances to the employment of the



composition of beeswax and paraffine, and, in some instances, to the employment of the paper or paste-board foundation upon which that particular composition is coated, and no pretense is made by the complainant in its moving papers that these claims are infringed. This leaves for consideration only the claims upon the method and machine for cutting the phonograph record in wax or waxlike materials, and the claims on the product, *i. e.*, the record, so produced. Considering now these latter claims, do the defendants infringe such claims? In other words, can the patent which describes the impracticable method and machine for cutting a phonograph record in a compound of beeswax and paraffine, and the impracticable record so produced, be held to cover the subsequently invented and successful method and machine for cutting the phonograph record in metallic soap and the subsequently invented and successful record so produced, simply because that patent has broad and nebulous claims for cutting the record in wax or waxlike materials?

The authorized purpose of the patent laws is to promote and not to retard the useful arts. This is the underlying thought which must control the Courts in the decision of the question of infringement.

In *Atlantic Works vs. Brady*, 107 U. S., 192, 200, Mr. Justice BRADLEY, in delivering the opinion of the Court, said :

“The design of the patent laws is to reward those who make some substantial discovery or invention which adds to our knowledge and makes a step in advance in the useful arts. Such inventors are worthy of all favor. It was never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufactures. Such an indiscriminate creation of exclusive privileges tends rather to obstruct than to stimulate invention. It creates a class of speculative schemers who make it their business to watch the advancing wave of improvement and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country, without contributing anything



to the real advancement of the arts. It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to lawsuits and vexatious accountings for profits made in good faith."

A patentee will not be permitted, by general and ambiguous language—by way of prophecy, as it were—to include more than his real invention, nor, by describing a certain and well-defined compound, to cover every other subsequently invented substance of which he had not the slightest conception. If an inventor has discovered the utility one thing of a class, he cannot, by a description of that thing alone, shut out further discoveries with regard to other things, unless the discovery of the utility of that which he has described gives to the world the information that the other things are likewise useful for the same purpose.

The real issue always resolves itself to this: Has the plaintiff made an invention which is new and useful, and which is in substance employed by the defendant, and has he pointed out and specifically claimed in his patent this invention as the thing for which he sought protection? As the Courts have many times decided that mere verbal limitations will not deprive the plaintiff of the control of that substantial invention which he really made and disclosed in his patent, so also the law is equally well settled that neither a happy choice of language nor the selection of a single, certain thing, such as a compound of bees-wax and paraffine, will warrant an expansion of the patent so as to bring within its scope more than the substance of the patented invention. If the law were otherwise, a patentee, by inserting general and vague terms in his patent, would be able to accomplish exactly that evil which this Court said, in *Atlantic Works vs. Brady*, should be guarded against. He would be enabled to embarrass "the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to lawsuits."

The courts, therefore, have consistently refused to expand the scope of claims based upon a specific dis-



closure, which is palpably the metes and bounds of the patentee's invention. They find the real invention of the patentee, and, if he has patented that properly, protect him in it.

We quote a few authorities illustrating the care with which the scope of the claim is limited to the real invention, as set out in the specification, which must be the real invention, in fact, in order to justify the claim.

In *Lamson Cash Railway Company vs. Goldhard*, 59 Fed. Rep., 776, 780, which was before the Circuit Court of Appeals for the Eighth Circuit, it appeared that the patent in suit claimed "the combination, with the way or ways, of one or more carriers, propelling devices," &c. The defendants used a single wire, upon which the carriers ran, and they contended that the patent was limited to a way consisting of "two or more" fine wires, and that, therefore, they did not infringe.

The Court said :

"There is not a line in the specification which will warrant the inference that the inventor ever contemplated the use of a track consisting of a single wire.

"As we have above shown, the specification and drawings clearly contemplate the use of a track consisting of two small wires placed side by side, and this limitation enters into the claims by necessary implication."

Thus, in the above case the claim was limited to the actual invention described by the patent in spite of the broader language of the claim, and was not permitted to cover anything beyond this.

In the late case of *Zan vs. McKenzie*, 62 Fed. Rep., 284, 285, the Court, in discussing the question of infringement, said :

"In deciding what is the invention covered by the complainant's patent, the Court must be controlled by the language of the claim and the description of the improvement, as set forth in the specification, and not by the construction which the patentee or his assigns, may have placed upon or claimed for the patent subsequent to its issue.

"If the language of the claim is broader than the description of the invention, the claim must be so inter-



*puted as to limit it to the improvement previously described."*

So, in *Pacific Railway Cable Co. vs. Butte City Railway Co.*, 58 Fed. Rep., 420, the claim was for "a turn-table combined with a slot and passage, &c., substantially as and for the purpose set forth;" and the device used by the defendant came within the literal reading of this claim. But in the specification no description was given of how the combination was to work if only one turn-table was used—the invention being throughout described as consisting in turn-tables used in duplicate. The Court said:

"While the claim may be broad enough, there is no description of how one table is to be used, except in connection with the other. In the claims, after describing a table, it is said it is substantially as and for the purposes set forth. This must refer to the description, and there it is set forth that the table constructed and described is to be used in duplicate."

The defendants were, therefore, held not to infringe.

*Folger vs. Semple*, 7 Bissell, 382, 384. The patent in suit was for a removably hinged tray in the body of a trunk, and to show want of novelty the defendant put in a prior reissued patent. Judge BLODGETT said:

"The hinge described in the reissue patent is the same as in the original. And, while the first claim allowed in the reissue is for 'a trunk provided with a removably hinged compartment tray,' yet there is no description or specification by which we are taught how to place a removably hinged tray in the body of a trunk. The whole description refers to placing the tray in the lid and nowhere else.

"It is well understood by all patent lawyers that *the claim must be for something described in the specification* so that any person of ordinary mechanical skill or skill in the art covered by the patent, can, from the specification, make a mechanism which will contain the claim."

To the same effect is *Rochester Coach Luce Co. vs. Schaeffer*, 46 Fed. Rep., 190, 191, affirmed by the Court of Appeals for the Second Circuit in 50 Fed. Rep., 106.

Thus it is seen that a patent cannot cover more than



the actual substance of the invention, no matter how broad the claims may be.

Admitting, for the purposes of this discussion, that the patent in suit, viewed, as it must be, in its true relation to the state of the art, has some validity, what was it that Bell & Taintor added to the art of recording and reproducing sound? The inevitable answer must be that they disclosed the fact that a mixture of *beeswax and paraffine* might be employed to receive a record, whereas Edison, Lambrigot, Cros and Carbonel had disclosed the fact that *waxes, including paraffine*, might be so employed.

Still, the complainant may say, although the defendants do not use a blank composed of beeswax and paraffine, they use an equivalent of it. This point the complainant has effectually shut itself out from making, by failing to assert an infringement of the claims which are limited in their terms to that composition. We have already pointed out that defendants' method, machine and product are neither the scientific nor practical equivalent of the patentee's method, machine and product. We have further stated, as evidence of the necessity of a separate and independent invention, that Mr. Edison's invention of the blank of metallic soap brought success to what was before a failure. A short discussion of the legal aspect of the doctrine of equivalents may not be out of place.

In the case of *Whitely vs. Swain*, 7 Wallace, 685, Mr. Justice NELSON calls attention to the fact that the difference between failure and success is such a substantial difference as affords a strong presumption that the successful invention was independent of, and different from, that which had failed.

In *Electric Signal Company vs. Hall Signal Company*, 114 U. S., 87, 98, the Court declined to hold that a ground return was the equivalent of a metallic return in the electric circuit of a railway signaling apparatus, although, generally speaking, no more familiar example of recognized equivalents could be cited, because the substitution in this particular case resulted in changing the mode of operation of the apparatus, thus producing

uniformity of electrical resistance and increasing the utility of the contrivance.

It seemed at one time as if one thing, to be an equivalent of the other, must have been known to be such at the time of the plaintiff's patent.

*Seymour vs. Osborne*, 11 Wall., 515, 556.

*Could vs. Rees*, 15 Wall., 187, 193.

*Gill vs. Wells*, 22 Wall., 1, 31.

*Inhaeuser vs. Burk*, 101 U. S., 647, 656.

In dealing with patents on pioneer or primary inventions, the rule of the cases next above cited is not now applicable, and it is possible that the actual knowledge of an equivalent structure at the time of the taking out of the patent, even on a secondary invention, would not be essential to enable the charge of infringement to be maintained. But the range of equivalents covered by a secondary invention cannot be broader than the substance of the invention will justify; and no one for a moment can contend that the inventor of the method of cutting a phonograph record in a composition of bees-wax and paraffine would be entitled to hold the radically different method employed by the defendants.

The Court will not forget that it cannot be successfully contended that the patents in suit are "pioneer" patents, or ones for primary inventions. They do not depart from the prior art except in the merest details. Edison obtained a primary or basic patent upon the phonograph in 1878, but a mere improvement in the method and material for accomplishing the same object cannot be given a similar position. Under these circumstances there is no room for the application of the doctrine of pioneer patents, and even if there were, we should still respectfully contend that the defendants' operations are not an infringement.

The doctrine of pioneer patents was established in the case of *McCormick vs. Talcott*, 20 How., 402, 404, where the Court says:

"In order to ascertain whether the divider used by defendants infringes that of complainant, we must first



inquire whether McCormick was the first to invent the machine called a divider, performing the functions required, or has merely improved a known machine by some peculiar combination of mechanical devices which perform the same functions in a better manner. If he be the original inventor of the device or machine called the divider he will have the right to treat as infringers all who make dividers operating upon the same principle and performing the same functions by analogous means or equivalent combinations, even though the infringing machine may be an improvement of the original and patentable as such. But if the invention claimed be itself but an improvement on a known machine by mere change of form or combination of parts, the patentee cannot treat another as an infringer who has improved the original machine by use of a different form or combination performing the same functions. The inventor of the first improvement cannot invoke the doctrine of equivalents to suppress all other improvements which are not mere colorable evasions of the first."

The above doctrine now stands among the fundamentals of the patent law, and has been so treated in the subsequent cases decided by this Court, some of which are ;

*Loom Co. vs. Higgins*, 105 U. S., 580.  
*The Richardson Steam Valve Case*, 113 U. S., 157.  
*The Morely Case*, 129 U. S., 263.  
*Sessions vs. Romalka*, 145 U. S., 29.  
*Royer vs. Coupe*, 146 U. S., 524.  
*Knapp vs. Morss*, 150 U. S., 221.  
*Miller vs. Eagle Co.*, 151 U. S., 186.

In the last-mentioned case this Court held :

" The range of equivalents depends upon the extent and nature of the invention. If the inventor is broad or primary in its character, the range of equivalents will be correspondingly broad under the liberal construction which the Courts give to such inventions. \* \* \* Tested by this rule, and in view of the prior devices, and the great variety of springs in use previous to the granting of his patent, Wright cannot be treated as a pioneer in the art. Neither can he nor his assignee be allowed to invoke the doctrine of equivalents such as the Courts extend to primary inventions so as to

include all forms of spring devices and adjustments which operate to perform the same function or accomplish the same results."

From what we have said above, it is very evident that Bell and Tainter were not pioneers in the art of recording and reproducing speech, but that they merely improved upon prior devices. They can, therefore, claim as infringements only those devices which are "colorable evasions" of the devices of their patents, as was said in *McCormick vs. Talcott*.

#### PATENT NO. 341,288.

The invention which this patent purports to describe, so far as it is pertinent to discuss it, is a recording tablet which, like the tablet of the prior patent in suit, is composed of a paper or pasteboard foundation with a surface coating consisting of a composition of bees-wax and paraffine. The difference over the device of the prior patent is that instead of forming the tablet in the form of a disk, it is made in the form of a cylinder. It is pertinent, upon the interpretation of such a patent with reference to the question of infringement, to show how narrow is the invention (if any at all exists) which is covered by the patent. Patent No. 341,214 is accepted by this patent as a part of the prior art (see paragraph immediately preceding claims), and hence Patent No. 341,288 must cover an invention distinct from the prior patent.

*Underwood vs. Gerber*, 149 U. S., 224; 37 F. R., 682.

Since the only distinction over the prior patent is giving the tablet a different form, and since that form was already old for phonograph tablets, having been described in Edison's patents already referred to (*ante* p. 11), it would appear that this Patent No. 341,288 rests upon an exceedingly slight foundation—*i. e.*, upon a mere change in the *form* of the tablet of the prior patent, which form was old for the same purpose.

The Supreme Court said in *Thompson vs. Boisselier*, 114 U. S., 1, 11 :



"It is not enough that a thing shall be new, in the sense that in the shape or form in which it is produced it shall not have been known before, and that it shall be useful, but it must, under the Constitution and the statute, amount to an invention or discovery."

And in *Smith vs. Nichols*, 21 Wall., 112, 119, it is said :

"A mere carrying forward or new or more extended application of the original thought, a change only in form, proportion or degree, the substitution of equivalents doing substantially the same thing in the same way by substantially the same means with better results, is not such invention as will sustain a patent."

This was quoted with approval in *Roberts vs. Ryer*, 91 U. S., 150, 159, and *Belding Mfg. Co. vs. Corn Planter Co.*, 152 U. S., 100, 107.

So in the leading case of *Winans vs. Denmead*, 15 How., 330, 341 :

"Under our law a patent cannot be granted merely for a change of form. The Act of February 21, 1793, § 2, so declared in express terms ; and though this declaratory law was not re-enacted in the Patent Act of 1836, it is a principle which necessarily makes part of every system of law granting patents for new inventions. Merely to change the form of a machine is the work of a constructor, not of an inventor ; such a change cannot be deemed an invention."

To the effect that mere change of form does not constitute invention, see, also,

*Busell Trimmer Co. vs. Stephens*, 137 U. S., 433.

*Packing Cases*, 105 U. S., 566, 575.

*Union Paper Bag Co. vs. Waterbury*, 58 Fed. Rep., 566, 567.

*Johnson Co. vs. Roller Mills*, 47 Fed. Rep., 586.

*U. S. Bung Co. vs. Independent Bung Co.*, 31 Fed. Rep., 76, 79.

*Matthews vs. Iron Clad Co.*, 22 Blatch., 427.

*Fryer vs. Maurer*, 22 Blatch., 268.

*Smith vs. Bridge Co.*, 8 Biss., 312.

*Wilson Packing Co. vs. Clapp*, 8 Biss., 545.

*Sangster vs. Miller*, 5 Blatch., 243.

*Wilbur vs. Beecher*, 2 Blatch., 132.



But it is plain from a reading of Patent No. 341,288 that the tablet which is covered by that patent is limited to a cylinder of paper or its equivalent, which is coated with the wax-like composition. The patent starts out by stating that :

"This invention \* \* \* consists principally in the following improvements: First. A new recording tablet is employed. It consists of a hollow cylinder or tube of paper or other suitable material coated with wax or wax-like composition, preferably a compound or mixture of beeswax and paraffine. The record is cut in the coating. The advantages of this form of tablet are that it may be very light, while having sufficient stiffness to retain its form, and avoid the danger of cracking the coating; that it is compact, and adapted for transmission through the mails or otherwise; that the recording surface is continuous, and that it can very readily be placed on and removed from the holder by which it is supported and rotated in recording and reproducing."

The first claim of this patent says that the tablet consists "of a hollow cylinder provided with a wax or waxlike coating," and the fourth claim refers to "a tubular self-sustaining tablet." These claims evidently refer, by the descriptive language which they contain, to the tablet consisting of a paper tube upon which a thin waxlike coating is placed. Apart from the language of the claims, they must be so interpreted in view of the statement of invention in the specification (*Snow vs. Railway Co.*, 121 U. S., 617, 629).

Since the defendants' tablets are not of the character thus described and claimed, and do not have any paper or equivalent foundation, but consist of a thick cylindrical body of metallic soap, which is not light, cannot be transmitted through the mails, and does not have the other characteristics of the tablet of the patent, they cannot be said to infringe the patent.

Further than this, since the patent describes a tablet having a coating of beeswax and paraffine, a tablet which is made of a metallic soap cannot be said to be the equivalent of the tablet whose recording surface is the compound of beeswax and paraffine, for the reasons which have already been given in connection with Patent No. 341,214.



## INFRINGEMENT IN VIEW OF LICENSES.

The licenses materially restrict the discussion of infringement. It was admitted at the argument that on the proof shown by this record, the phonographs which the defendants employ have come lawfully into their possession and are licensed under the patents in suit. If these machines are licensed, it follows necessarily that their use for the purpose for which they are designed is also licensed, as well as the product which they are intended to produce. In other words, if a patentee, having a patent upon a machine, upon the method which the machine necessarily employs in its use, and upon the product of that machine, he licenses a purchaser of that machine in all three of these particulars by the fact of the sale of the machine itself, because the machine would be useless to the purchaser unless he could operate it, and in operating it he must necessarily produce the product. Consequently, no infringement of the first Patent No. 341,288 can be found, because the claims on the method, machine and product are certainly licensed, and because the infringement of the claims upon the tablet is not charged, and such claims are limited to features which the defendants do not employ. The license situation, therefore, restricts the charge of infringement to the second patent, a patent whose validity is extremely doubtful, to say the least, and whose scope is clearly so restricted as not to include the defendants' tablet. But even the tablets of the second patent cannot be said to be free from the license situation. The complainant's attitude at the argument was that while defendants' machines might have been put out at a time the licenses were in force, yet that cannot be said of the tablets which the defendants employ, because such tablets are articles of continuous manufacture, being soon destroyed by their use, and therefore the defendants must be employing tablets of recent manufacture. But this attitude of the complainant assumes what is not proved, namely, that the licenses did come to an end and are



not now in force. The defendants have shown the license of the Edison Phonograph Works to make these blanks and the license of the local companies to use and sell them. This threw the burden upon the complainant to prove that the licenses were no longer in force, but the complainant did not do this; on the contrary, it filed a rebutting affidavit of the active officer of the complainant company, Mr. Easton, who did not even deny the defendants' statements as to the license situation. At the argument complainant's counsel took the position that the defendants were not only obliged to prove the licenses, but also to go further and prove that such licenses had never been canceled, but since such licenses on their face are still in existence the defendants have certainly made that proof as far as it could be required of them and the burden is upon the complainant to show that the fact is otherwise than appears from the face of the licenses themselves.

### **3. Defendants' operations are authorized by license under the patents in suit.**

This phase of the litigation, which has been briefly referred to as the "contract situation," may be concisely stated as follows:

The complainant granted to Jesse H. Lippincott a license under numerous graphophone patents, including the patents in suit. Lippincott thereupon, with a view to centralizing the whole talking-machine business, and controlling it through either himself or a corporation to be formed by him, secured rights under the Edison phonograph patents. In order to escape from the obligation which he was under to the American Graphophone Company not to handle other machines, he entered into a contract to pay said Graphophone Company ten dollars on each phonograph placed upon the market. Lippincott thereupon proceeded to organize the parent talking-machine corporation, known as the North American Phonograph Company, and in connec-



tion with this company secured the organization of local companies, among whom were the Kansas and New Jersey Phonograph Companies, from whom the defendants herein have bought their phonographs and supplies. These local companies were licensed under the patents in suit as well as under those on the phonograph.

On August 1, 1888 (D. Rec., p. 41, fol. 163), an agreement (reproduced at D. Rec., p. 46) was entered into between Mr. Edison, the North American Phonograph Company and Lippincott, in which Mr. Edison's right to manufacture phonographs and phonograph supplies was acknowledged. A standard graphophone and a standard phonograph were produced and identified and an agreement entered into that neither interest should appropriate the improvements made upon the machine of the other. Mr. Edison's interest in this contract between Lippincott, the North American Phonograph Company and himself was subsequently transferred to and operated under by the Edison Phonograph Works (D. Rec., p. 42, fol. 165). The phonograph blanks used to-day are manufactured by the Edison Phonograph Works, and the phonographs used by the defendants were so manufactured under this contract.

The contract of August 1, 1888, was acknowledged and confirmed by the complainant by an agreement between it and Mr. Lippincott, dated August 6, 1888 (reproduced D. Rec., p. 50), the purpose of which was to ratify the various arrangements which Mr. Lippincott had theretofore made, including the arrangements made by said contract of August 1, 1888. Mr. Edison shows (D. Rec., p. 42, fol. 166) that he has scrupulously observed his obligations under these contracts.

The foregoing brief statement of the contract relations between the two interests illustrates the situation at the time it was submitted to Benjamin F. Thurston for his opinion. The extract from that opinion is contained in Mr. Edison's affidavit (D. Rec., p. 43, fol. 169). Mr. Thurston said:

"The title to the Edison phonographs patents resides in the Edison Phonograph Company. The title



to the graphophone patents resides in the Volta Graphophone Company. The exclusive right to manufacture Edison phonographs under these patents resides in the Edison Phonograph Works. The exclusive right to manufacture graphophones is vested in the American Graphophone Company. The exclusive right to use, lease and sell both the phonograph and the graphophone is vested in the North American Phonograph Company."

This situation was, as we have said, set up in defendants' answering affidavits, and although complainant's vice-president and general manager was given an opportunity by defendants' counsel to file an affidavit herein at the eleventh hour, he did not dispute or contradict it in a single particular.

As to the operations of the local companies through whom the defendants do business:

Under the licenses with them, the North American Phonograph Company, of which Mr. Lippincott was president, supplied them with both phonographs and graphophones. The graphophones, to the number of about three thousand machines were, as we have seen, returned to the North American Phonograph Company as uncommercial (D. Rec., p. 88, fol. 349). These were eventually shipped to the Edison Phonograph Works, there thrown into scrap, and nearly, if not quite, all replaced by phonographs (D. Rec., p. 39, fol. 154). The phonographs made by the Edison Works were billed to the North American Phonograph Company. An account was kept with the American Graphophone Company, and said company, from time to time, rendered Lippincott or the North American Company, his assignee, statements of account for the sum of ten dollars on each phonograph, and these sums were paid either by Mr. Lippincott's check, or by that of the North American Company.

This situation is brought out very clearly in the affidavit of Mr. Walcutt (D. Rec., p. 83 *et seq.*), and that of Mr. Lombard (D. Rec., pp. 81, 82).

Mr. Walcutt also shows (D. Rec., p. 85, fol. 340) that the last account rendered by the Graphophone Com-



pany against Mr. Lippincott for royalties on phonographs and supplies was so rendered on April 30, 1891, while the last shipment of phonographs was made prior to February 1, 1891.

We need not proceed farther with this phase of the situation, for it has been conceded that the machines which found their way into the hands of the local companies prior to April 30, 1891, were rightfully made under the authority vested in Lippincott and the North American Phonograph Company, and it is well settled that these machines having been rightfully marketed, are protected in the hands of users.

Adams vs. Burke, 17 Wall., 453.

Hobbie vs. Jennison, 147 U. S., 355.

The exceedingly narrow ground taken by complainant's counsel is that the only right the local companies and users acquired with those phonographs, however, was the right to employ them with the very limited number of blanks which were furnished at the time of sale or prior to some date not fixed or proved, when, the complainant contends, the licenses came to an end. We believe the weakness of this position was fully appreciated by this Court on the argument of this motion, when complainant's counsel was asked whether, the purchaser of a machine was not furnished with an adequate number of blanks, without which the machine would be totally useless. As a matter of fact, the machines when sold were accompanied by a very limited number of blanks, numbering probably a dozen or so, while the machines are capable of recording and reproducing sound for an indefinite length of time, and one machine might use up hundreds of blanks during its own lifetime.

The operations of the various interests, as outlined above, are practically the same to-day. The phonographs shipped prior to February 1, 1891, are now in the hands of the local companies and their vendees, such as the defendants herein. The Edison Phonograph Works has, by virtue of its rights, proceeded with the manufacture of blanks, and these



blanks are being and have been for several years past, supplied to the local companies for use upon those machines. The defendants secure their blanks from the Kansas and New Jersey Companies, which companies in turn secure them from the Edison Phonograph Works, acting therein merely as jobbers. It is decidedly unreasonable and inequitable to contend that the users of phonographs, among whom are the defendants, should be restrained from the use of those machines except in connection with the few blanks with which the machines were originally sold, and this, we believe, to be the sole contention of the complainant upon this motion.

The Court will understand that the phonograph is an expensive machine, capable of use indefinitely, and that if a user were restricted to the few blanks which were furnished with the machine, and which are necessarily perishable in their nature, we venture to say that not a single machine would have been sold.

As a matter of fact, the blank now being manufactured by the Edison Phonograph Works is the metallic soap blank of the Edison Patent No. 430,274, but the situation being as we have just outlined, undoubtedly said works have the full right and authority to make the old blank of the Bell and Taintor patents, consisting of a pasteboard tube coated with beeswax and paraffine. But, the complaint says, "Here is a concern operating under our patents and failing to pay us royalties." This assumes, of course, that the metallic soap blank is an infringement upon the pasteboard tube with the beeswax and paraffine coating, which we think we have clearly shown is not the case. But even suppose that they were right in their contention, this can give no ground for relief in the present action, for such relief, if obtainable at all, must be through an action at law for an accounting.

The licenses on their face are still running, and the complainant has made no attempt to show that they have come to an end. It is maintained, and will be at final hearing, that these licenses run to 1903. They



fully authorize the defendants in doing everything the have done. Where, then, has the complainant been injured?

**4. The owner of a patent is prima facie not an infringer. The present defendants operating under authority of the Edison Patents are therefore exempt from injunction, certainly before final hearing on the merits.**

*Corning vs. Burden*, 15 How., 270 (1853). Opinion by Mr. Justice GRIER. This appears to be the first case laying down this proposition. The Court said:

"It is evident that a patent thus issued after an inquisition or examination made by skillful and sworn public officers appointed for the purpose of protecting the public against false claims or useless inventions, is entitled to much more respect as evidence of novelty and utility, than those formerly issued without any such investigation. Consequently, such a patent may be, and generally is received as *prima facie* evidence of the truth of the facts asserted in it. And in cases where the evidence is nicely balanced it may have weight with a jury in making up their decision as to the plaintiff's right, and if so, it is not easy to perceive why the *defendant, who uses a patented machine*, should not have the benefit of a like presumption in his favor arising from a like investigation of the originality of his invention and the judgment of the public officers that his machine is new and not an infringement of the patent previously granted to the plaintiff. It shows, at least, that the defendant has acted in good faith and is not a wanton infringer of the plaintiff's rights, and ought not, therefore, to be subjected to the same stringent and harsh rule of damages which might be justly inflicted on a mere pirate."

*Putnam vs. Keystone Bottle Stopper Co.*, 38 F. R., 236, ACHESON, J. On motion for injunction: The suit was based on two patents, one of which, the defendants claimed, was anticipated by a prior patent to the same



patentee. The Court said that it did not concur in this view :

"From the mere grant of the patent there arises a fair presumption that there is a *substantial difference involving invention* between the two patents, and that the later one is for a patentable improvement upon the earlier patent."

*Worswick Mfg. Co. vs. City of Kansas*, 38 F. R., 246.  
BREWER and PHILLIPS, JJ. March 4, 1889 :

The suit was based on a patent to Sullivan for suspending harness. The defendant manufactured under a patent to Hale. The Court said :

"The general rule is that the issuance of a patent is presumptive evidence of the novelty and utility of the device, and it devolves on him who defends upon the ground of an anterior discovery and use to show it by such convincing proof 'that the Court can say without hesitancy that the allegations of the answer are true.'  
\* \* \* In a controversy between two such patentees, the above rule does not apply further than that the complainant, in making out a *prima facie* case, may stop after putting in evidence his patent. The rule in question rests upon the fundamental postulate that by the act of granting the patent department officials adjudge that there exists, *prima facie*, a patentable device possessing novelty and utility."

*National Harrow Co. vs. Hanby*, 54 F. R., 494,  
COXE, D. J., March 2, 1893 : Both parties were manufacturing under different letters patent. The Court said :

"The fact that the defendant's harrow is patented is *prima facie* proof that it does not infringe."

*Carl L. Jensen vs. Clay*, 59 F. R., 292, ACHESON, C. J., December 22, 1893 : The suit was based on the Jensen Patent for pepsin. The defendant proved that his pepsin was made under the Russell Patent. The Court said :

"From the mere grant of the Russell Patent there arises a presumption that the process therein described is distinct from that of Jensen."



5. Complainant has failed to make out a case of acquiescence such as will take the place of a prior adjudication.

This consideration is vital. It goes to the very essence of the present motion. The defendants are sufficiently confident as to the failure of complainant's showing as not to take advantage of the very pertinent proposition that complainant should not be heard on the question of acquiescence, since it has failed to set up such acquiescence in its bill. The authorities on this subject, however, are interesting; among them are:

"Where a special injunction is sought *ex parte*, complainant should state in his bill *all the material facts* bearing upon the subject matter in controversy, and should set out all documents having material bearing upon the case, so far as they touch the right to the relief sought" (High on Injunctions, 3d Ed., Sec. 1575).

Again, in *International Tooth Crown Co. vs. Mills*, 22 F. R., 659, it was shown, on motion for a preliminary injunction, that the complainant relied upon the effect of certain conditions in a license asserted to have been taken by defendants from the complainant under the patents in suit. In denying the motion Judge WALLACE said:

"There are no allegations in the bill of complaint that such licenses were ever granted by complainant or accepted by defendant, or any to show that the defendants are not ordinary infringers, and proof of such facts would not, therefore, be considered if the case were here upon final hearing. \* \* \* Enough may be spelt out from the affidavits of the defendants and from the answer to the bill to supply these omissions, though not without difficulty. *But the Court should not be asked to spend much time to find out whether the vital facts upon which the moving party relies, but which he has not taken the trouble to assert, can be exhausted from any other source.*"

See, also, *Leo vs. Union Pacific Railway Company*, 17 F. R., 274, 275.

To leave this technical point, however, and to consider whether or not a showing of acquiescence on the

part of the public has been made out, it will be seen that the complainant apparently relies upon the affidavit of Bell to establish this proposition, and that while this affidavit is fertile in conclusions it is barren of premises. We "spell out" from this affidavit, however, that the complainant relies upon two things as establishing recognition of the "value, validity and fundamental character of the graphophone patents." One of these is the contract between the complainant and Lippincott, and the other the sale of the corresponding foreign patents for the sum of five hundred thousand dollars. The first of these we shall discuss more fully hereafter. It is sufficient for present purposes to say, and we believe that it is fully borne out in defendants' case, that the complainant's sale of a license to Lippincott was simply a case of barter and sale. Lippincott took the license, of course. It was a case of *caveat emptor*, and it was not until he attempted to put the graphophone upon the market that he discovered what an impracticable and unstable embryo it was. Indeed, the knowledge of this came to him before he attempted to market the graphophone, for prior to this time the negotiations under which Lippincott acquired his rights to the Edison patents were carried on and concluded, and both machines were placed upon the market at the same time. Now, there has been a misleading contention on the part of the complainant that, recognizing the scope and validity of the graphophone patents, including those here in suit, and infringement upon them by the use of phonographs made under the Edison patents, Lippincott, in order to bolster up his right to market both machines, agreed to pay the sum of ten dollars upon each phonograph he put out. As this subject is left by the complainant's moving papers, it intimates an acquiescence by Lippincott, and consequently by the local companies organized through him and the North American Phonograph Company, in the validity of all of the graphophone patents under which Lippincott was licensed. This is entirely erroneous, as is shown by the defendant's affidavits. The truth of the whole matter is simply this: Lip-



pinecott, through first negotiating with the graphophone interests, entered into a license which restricted his operations in sound recording and reproducing machines to the graphophone. He agreed, in so many words, to handle no other device of this general nature without the consent of the American Graphophone Company. He had, however, a very wholesome regard for the patents of Mr. Edison, and this is shown by the fact that before he attempted to operate under the graphophone license, he secured rights under the Edison patents, and by reason of his agreement with the Graphophone Company not to deal in phonographs, and further, through the fear on the part of the graphophone interests of the superseding of the graphophone by the improved phonograph, the American Graphophone Company required Lippincott to make them whole in the premises by paying to them, to escape from the restriction in his license, a sum which would increase correspondingly to the number of phonographs sold. This was undoubtedly, and as the result proved, a wise scheme. Had the Graphophone interests required a lump sum to be paid before Lippincott could escape from his agreement, there would probably not even have been the attempt on Lippincott's part to market the graphophone. As it was, however, it is easy to believe that the American Graphophone Company had before it the constant fear that the graphophone would not meet with the same degree of commercial success as would the phonograph, and they therefore required a certain sum upon each phonograph put out. This negotiation and settlement is set forth in defendants' affidavits to be clearly a business compromise, having no relation to the validity of any patents whatever, but entered into solely for the purpose of extricating himself from the predicament in which he had inadvertently been placed by his contract with the graphophone people.

We invite the attention of the Court to Mr. Edison's affidavit (D. Rec., p. 40, fol. 158 *et seq.*) and the affida-



vit of Mr. Lombard (D. Rec., p. 81), which is very short and which sets forth the truth of this situation.

The second ground upon which Mr. Bell finds acquiescence by the public in the validity of the graphophone patents is, as stated in the affidavit, of some weight, but, in connection with the remainder of the story it becomes without force. It appears from the affidavit of Mr. Edison (D. Rec., p. 39, fol. 159 *et seq.*) that the company to which these graphophone patents were sold, namely the International Graphophone Company, did, as Mr. Bell says, pay a large sum of money for the British Patents corresponding to the United States Patents upon the graphophone. This purchase was entered into under a misapprehension as to the practical character of the graphophone. The International Company established a plant in this country, and began the manufacture of machines. The enterprise was a failure, and in order to prevent a total loss the International Company found it necessary to secure rights under the British Edison Patents, and this was done. As a result, a new company was formed, called "The Edison United Phonograph Company," one-half of whose capital stock was paid for rights in the phonograph, the other half of the capital stock being paid for the rights of the International Company. Furthermore, the factory which had been established for the manufacture of graphophones was given up, and several hundred of those machines were sent to the Edison Phonograph Works, and there turned into scrap. Since that time, the United Company has been marketing the Edison phonograph, and is dealing exclusively in that instrument at the present time.

What are the facts shown by the defendants, other than those just discussed? Mr. Tewksbury, who has been connected with talking-machine interests since their inception, and who is therefore an acknowledged authority upon the subject, shows that it is untrue, as stated in Mr. Bell's affidavit, that the claims of novelty, originality and merit in the graphophone patents have never been seriously disputed; that these subjects have always



been in dispute, and that it is generally conceded that Mr. Edison has been and is regarded all over the world as having originated the commercially successful phonograph; and further the complainant's moving papers show (affidavits of White, Clephane and Devine) that when its representatives called upon Mr. Edison in October, 1887, he told them that "the so-called graphophone improvements had been invented by himself."

Of course, we use the term "commercially successful" in its relative sense, for, as we have intimated heretofore, there is not to-day a truly commercially successful machine. Whether or not this is true, the fact remains that the phonograph is a very much more practical and successful machine than the graphophone, and that the latter, without those features which give the phonograph success, would be without even the small meed of success which is claimed for it.

Of course, the best showing of acquiescence by the public in the validity of a patent is that apparatus constructed under that patent has gone into general and extended use; that it has had the whole field to itself, and that no rights of others have been set up adversely to such patent. There is not a scintilla of evidence now before the Court to show that this was the case with the graphophone. On the contrary, we believe the defendants' affidavits establish, so far as is within human power to establish, the fact that there has been no recognition of the patents themselves, and so far from being any recognition on the part of the public in the merit of the patents and of the apparatus constructed under the same, there has been a long-continued adverse attitude, not only on the part of manufacturers, but also on the part of the jobbers and users. Again, it is a very essential element of acquiescence that the apparatus constructed under the patents be practicable and successful. The complainant appears in court to-day absolutely unable to dispute the proposition that the number of graphophones in use is almost infinitesimal as compared with the number of phonographs. Further than that, we have conclusively shown



that were it not for the appropriation by the graphophone of those features which give the phonograph success, there would not, in all probability, be even this small number of graphophones in use.

As we have said, the question of utility and especially how far the utility of apparatus constructed under letters patent is acknowledged by the public, is one which is vital to that complete showing of acquiescence which will take the place of a prior adjudication. And there is hardly a line in defendants' affidavits which does not militate against the complainant's proposition of utility and merit in the graphophone.

Mr. Edison shows (D. Rec., p. 39, fol. 153) that the arrangement made by Mr. Lippincott with the Edison and the graphophone interests was that the phonograph and the graphophone should be placed upon the market concurrently; that no effort should be made to push the sale of one at the expense of the other; and that purchasers should be allowed to make their own selection between the two machines. In pursuance of this contract, some three thousand graphophones were delivered to Mr. Lippincott by the complainant and these he attempted to market by sending them out to prospective users. Every one of these machines came back to Mr. Lippincott, and were finally sent to the Edison Phonograph Works and there turned into scrap. This, as we have shown above, was the same fate which the several hundred machines made for the British concern also met with.

Again, the affidavit of Mr. Dodge, who has been connected with either one interest or the other for several years last past, clears up any doubt which may exist upon this subject. Mr. Dodge was for some time in the employ of the complainant as an agent, his duties contemplating the introduction of the graphophone. It is reasonable to suppose that he used every endeavor which a capable and intelligent man could use for disposing of graphophones. He says in his affidavit (D. Rec., p. 96, fol. 384 *et seq.*).

"During the period that I represented the Graphophone Company, both in New York and Washington,



although I daily attempted to make sales of graphophones, I was wholly unable to do so, and my failure I attribute to the fact that the machine was impracticable and would not answer the purpose for which it was designed."

It is a well-settled proposition of law that acquiescence on the part of the public in the validity of letters patent sufficient to warrant an injunction thereon must be open, continuous and notorious. It is not sufficient for the complainant to show that it has held the title to the patent. It is not even sufficient to show that in a few specified cases the infringer has desisted from his wrongful acts upon having his attention called to that patent. The complainant must show a user under the patent adverse to the public and adverse to the interest of other operators in the same field. How can it be contended that the complainant has made out such a case of acquiescence? It has shown no substantial user at all of the graphophone of the patents in suit.

Not only has complainant failed up to a very recent date to market a practicable machine, but it has stood passively by while large phonograph interests were being built up. It has been well aware, during this time, of these interests, and of their operations, and has acquiesced in and encouraged them (D. Rec., p. 59, fol. 234). It now comes into equity with unclean hands, and asks the Court to grant them that relief which can only be granted where, all else being in favor of complainant, a full and complete showing of acquiescence by the public in its rights has been made out.

In this connection we call the attention of the Court to Walker on Patents (2nd Ed), Sec. 667, which reads:

"Public acquiescence sufficient to create a presumption of validity, and therefore sufficient to furnish a foundation for a right to a preliminary injunction may arise out of either of two classes of facts. It may arise where the patentee has made and sold specimens of the patented article for many years, during which no other person assumed to make such specimens, or it may arise where the patentee long licensed others to make, use or sell such specimens, while nobody assumed to



do either without such a license from him, and the acquiescence is quite as positive in this case as in the other. But acquiescence in exclusive use of a thing which contains several patented inventions does not raise a special presumption of validity in favor of any particular one of the patents involved, and when acquiescence stops, for good reasons the special presumption of validity which rested upon it comes also to an end."

Of the two classes of facts referred to by Mr. Walker, both are missing from the present case. Thus, neither the patentee, the complainant, nor its predecessors have "made and sold specimens of the patented article for many years." This we have discussed heretofore, and the discussion need not be repeated. The other class of facts is that in which it appears that the patentee long licensed others to make, use and sell such specimens, while nobody assumed to do either without such license from him. If we assume that the complainant is not to be taxed with the delay during which Lippincott personally was operating under the patents in suit; that is to say, that they are not answerable for laches prior to May, 1891 (and this we believe to be very reasonable), what has the complainant done from May, 1891, down to December, 1894? Has it, during that time, granted any licenses to others to do that which it has been, certainly until very recently, unable to do? And if it has, the question naturally suggests itself whether such licenses have during that time been operated under. And the answer in each case must be no.

Robinson on Patents (Vol. 3, p. 590) treats the subject of acquiescence as follows:

"Acquiescence in reference to this subject is a voluntary submission *against interest* to an *asserted right*. In the first place, the right must be asserted. The issue of a patent is not of itself such an assertion. Where the patentee alone employs the invention in secret or on his own premises without competition or attracting public notice, and where he neither exposes his monopoly of the violation, nor vindicates it when it is attacked, there is no right asserted in which the public or an individual can acquiesce. Again, the as-



serted right must be antagonistic to the public interest, at least to the interest of that portion of the public who are generally benefited by the use of such inventions. If the invention is *without utility*, or if through some mistake as to its character the public are convinced that it is *worthless*, and there is *no demand for nor desire to use it*, their passive indifference to the exclusive claim of the inventor indicates *no public recognition of its validity*."

The complainant has failed to make out its case under this theory of the doctrine, because it has failed to show an assertion of right on its own part prior to the commencement of the suits against the Edison Phonograph Works and the Columbia Phonograph Company, and it has failed to show a voluntary submission against interest by the public. So far as the former is concerned, the complainant has, since the commencement of those suits, instead of asserting its rights under the patents, aided and encouraged the very concern against whom it now asks a preliminary injunction. As we have shown heretofore, there has been no submission of the public, either voluntary or involuntary, to any right of the complainant, either asserted or unasserted, but, on the contrary, that portion of the public which has use for sound recording and reproducing machines has for a number of years last past used phonographs exclusively. The entire subject is quite within the purview of the latter part of the quotation from Mr. Robinson's work, where he refers to the invention being without utility. It is a fact, as we believe we have shown heretofore, that there is no demand for, nor desire to use, the invention, inasmuch as it is without utility, and, therefore, the passive indifference of the public to any right which may be vested in the complainant cuts no figure whatever in the suit at bar.

Patent practice on the subject of preliminary injunctions has long since passed the point where it is only necessary for the complainant to aver acquiescence on the part of the public. As an instance of the extent to which the complainant must go in his proofs where the patent has never been adjudicated, we refer to the case



of *Hurlbert vs. Carter & Co.* (39 Fed. Rep., 892), in which Judge COX said:

"There is no proof of acquiescence. True, a general statement that the patent has been recognized and respected by the public appears in one of the affidavits, but is unsupported by facts. Names, places and figures are wanting. An indefinite averment of this character avails but little, especially when it also appears by the moving papers that infringing devices in large numbers have been openly sold and used since January, 1887, in the complainant's own city."

In this connection we call the attention of the Court to the fact that the case was decided in September, 1889, and, therefore, the period of time during which the infringing devices had been sold was considerably less than three years, while in the present case there has been a delay of nearly six years since phonographs were first put out, and of nearly three and one-half years since the failure of Mr. Lippincott, when, according to the moving papers, the complainant was called upon to act.

Again, in the case of *Barr Co. vs. N. Y. & N. H. Sprinkler Co.* (32 Fed. Rep., 80), on motion for preliminary injunction, it appeared there had been no previous adjudication on the patent, and that the complainant sought to make out an equivalent showing of acquiescence. Judge LACOMBE said:

"The only proof of acquiescence is a general allegation in the bill. No facts bearing on this case are disclosed. Nearly three years have elapsed since its issue, but to what extent specimens of the patented article were made and sold by the patentees or under their license, or, indeed, whether any one ever made or used such apparatus, does not now appear. The complainant, therefore, has not made out such a *prima facie* case as entitles him to a preliminary injunction under the first patent."

This case is very much in point, for the reason that, excepting for the fact that the averment of acquiescence is in the bill, it is the same in nature as the averment in the affidavit of Bell. That is to say, it is a general



allegation, while no facts worthy of consideration are disclosed. Neither does the bill show to what extent specimens of the patented article were made and sold by the patentees, and it is easy to understand why such showing was not made, for the number of machines so made and sold would, beside the number of phonographs sold and now in use, appear ridiculous.

In the case of *Grover vs. Williams* (2 Fisher, 136), a motion for preliminary injunction was made, and in the absence of a prior adjudication acquiescence was set up, and in its support the complainant showed that in three cases suits had been brought against infringers who submitted to the patents without contesting them. The Court said :

"Now, submission in three cases out of numerous cases of infringement cannot show a general acquiescence under the reissue, even if those suits had been founded upon the reissue patent alone, though they were not. \* \* \* I cannot consider, therefore, that there is any such evidence of exclusive possession or acquiescence under the reissued patent as can be said to strengthen the presumption of right in the plaintiffs to that patent. It would seem rather to the contrary—that it has been contested and disputed practically by numerous persons making the machine from the time almost of that reissue."

It is further a well-established proposition, to support which needs no citation of authorities, that where a machine is covered by a number of patents owned by different parties, acquiescence cannot be said to operate in favor of one of those patents as distinguished from the others. The Edison phonographs and blanks are covered by numerous patents of Mr. Edison, and the extensive use of these machines and devices must be taken rather as an acquiescence in Mr. Edison's Patents than as an acquiescence in the graphophone patents. Especially is this so, when, as appears by the record, the graphophones have not been extensively used but have been superseded by the phonograph. Under these circumstances, the public user, such as it is, supports the defendants' position and not the complainant's.



6.—Special relief by preliminary injunction will not be granted where it appears that complainant has acquiesced in and encouraged the operations of the defendant.

We have heretofore discussed the facts bearing upon this proposition, and it will not be necessary to repeat them. We wish, however, to refer to one or two authorities bearing upon the subject, among which are High on Injunctions, Section 965, which says :

“In considering applications for relief by injunction against the infringers of patents, courts of equity require of the patentee due and reasonable diligence in the assertion of his rights, and a long and unreasonable delay in invoking relief or *acquiescence for a considerable length of time in the infringement complained of* may afford sufficient ground for refusing an injunction.”

Of course, apart from complainant's acquiescence in defendants' operations, as shown by its dealing with the defendant company and its officers (D. Rec., p. 59, fol. 234), there is a constructive acquiescence, arising out of complainant's knowledge of the defendants' operations. Mr. Tewksbury shows that the complainant has been aware of the operations of the defendant company since its organization (D. Rec., p. 58, fol. 232).

In *Spring vs. Domestic Sewing Machine Co.* (4 B. & A., 428), where on motion for preliminary injunction the complainant set up public acquiescence, the Court said :

“As to public acquiescence the affidavits filed in the case by the complainants to sustain this application show that many have not acquiesced, and that the owners of the Spring Patent have been aware of the alleged infringement of the defendant corporation for two years past.”

The duration of defendants' alleged infringement in this case was substantially the same as in the case at bar.



7. Complainant is not equipped or prepared to supply the trade with blanks. The rights of the trade and of innocent users would, therefore, be violated by the relief prayed for.

The defendants' affidavits show that the users of phonographs are to-day depending entirely for their supply of blanks of metallic soap, which are the only successful blanks, upon the Edison Phonograph Works. The complainant, although it has attempted for a long time past to manufacture a commercial blank, and has carried on experiments continuously at its factory, is to-day using either an impracticable and uncommercial article of its own manufacture, or blanks made by the Edison Works under the Edison Patent No. 430,274.

The story, as told in the affidavits of Messrs. Tewksbury and Dodge, of the so-called "blue blanks" manufactured by the complainant, is very interesting, as going to show the inability of the complainant to make a practicable blank for talking machines (D. Rec., 361, fol. 243; and 393, fol. 372). This story is briefly as follows:

In the spring of 1893, prior to which time the complainant had employed blanks composed of soft, viscous material mounted upon a pasteboard tube, the complainant commenced using upon graphophones Edison metallic soap blanks, obtained through the Columbia Phonograph Company, and its machines were provided with the tapering mandrels peculiar to the phonograph in order to permit them to use these soap blanks. Thereafter, however, with a view to devising and constructing a practical blank, the Graphophone Company carried on experiments at its factory at Bridgeport, Conn., one of the experimenters being Mr. Dodge himself. Many experiments were made, with the result of producing a blank consisting principally of hard, metallic soap, but with an admixture of some material or possessing some other peculiarity of construction which occasioned a thick bluish-white incrustation to appear upon the surface of the blank which rendered it totally unfit for use

Blue  
blanks



in recording sound. Particularly was this so when one of these blue blanks, as they were called, was provided with a musical record where many of the sound vibrations were quite delicate. The manufacture of these blanks was, nevertheless, carried on to considerable extent.

The impracticable and uncommercial nature of these blanks is without dispute and has been conceded by the complainant. The affidavit of Mr. Tewksbury (D. Rec., p. 61, fol. 244) sets forth a transaction between the complainant and the defendants, in which the complainant against the judgment of the defendants provided them with a thousand of these blue blanks, upon which the defendants were to place musical and other records. The blanks were found to be total failures and were returned to the complainant. A copy of the portion of the defendants' letter notifying the complainant of the failure of the blanks will be found at page 62 of defendants' record, folio 247, where the blanks were stigmatized as "inferior and detrimental to our trade," and as having "something wrong in the composition or its preparation." In response to this, Mr. Easton, the vice-president and general manager of the complainant, wrote continuing the arrangement as to the production of musical records upon blanks, and saying that until further advised he would furnish the defendants with *Edison blanks* for this purpose.

The ability of the complainant to supply a commercial and successful blank is pertinent herein not only on the proposition (heretofore discussed) that the disclosure in the patents in suit was insufficient to enable either the patentees or the public to carry the invention into effect, but also on the proposition that the complainant's inability to take the place of the defendants, whom it wishes to usurp in the trade, by reason of its inability to supply users with practicable blanks, provided with records militates against special relief by preliminary injunction.

Mr. Tewksbury sets forth in his affidavit (D. Rec., p. 63, fol. 251) that the inability of the complainant to supply a practicable and commercial blank for use



upon either the phonograph or graphophone continues to the present day; that it is not even now in a position to supply the trade, and therefore to enjoin the defendants from using and selling the Edison soap blanks would, so far as said defendants and their very many customers all over the country are concerned, throw the entire business to the ground.

It is true that the eleventh hour affidavit of Easton states that the cylinders now manufactured by the complainant give superior results. If this statement in the affidavit is to be regarded as proof, we can only say that it is wholly inadequate. A cylinder is not produced, nor has there been any expression of opinion as to its utility save that of Mr. Easton. The language of his averment is not convincing. We have no doubt that the complainant can manufacture a cylinder to-day which will, as compared with the old pasteboard tube coated with wax and paraffine, give "superior results." But without hesitation we deny that the complainant is to-day able to take the place of the Edison Phonograph Works in the manufacture of phonograph blanks or that of the defendants herein in providing such blanks with records. The bare statement of Mr. Easton, wholly unsupported, is entirely inadequate to overcome the very strong showing made out by defendants through the affidavits of Messrs. Tewksbury and Dodge.

In this connection it might be well to mention the fact that there are in use to-day a large number of sound-reproducing machines intended for exhibition purposes and provided with automatic mechanism actuated by a coin, which is designed to reproduce musical and other records from phonograph blanks, this industry being one which has to a large extent been kept separate from the industry of providing those blanks with records. This reproducing business would fail completely, while the other industry of providing blanks with records would necessarily cease.

There is but a single concern doing business to-day capable of supplying a commercial blank for phonographic use, and that is the Edison Phonograph Works,



from whom, through the channels organized by Lippincott with the knowledge and consent of the complainant, and immediately from the local licensed companies, these defendants obtain their supplies.

The inevitable conclusion arising from this state of facts, therefore, is that not only will an injunction herein operate to drive the defendants entirely out of the business, but will preclude the supplying of phonograph supplies (*i. e.*, records) to the public, whereby said public will be left with useless phonographs upon their hands, and generally will suffer great inconvenience through the loss to them of that thing which makes the machine for which they paid a large sum useful.

In *McElroy vs. Kansas City*, 21 F. R., 257, in a suit brought to restrain the city from grading a street, Judge BREWER said :

"FIRST. A Chancellor, in determining an application for injunction, must regard not only the rights of the complainant which are sought to be protected, but the injuries which may result to the defendant or to others from the granting of the injunction.

"If the complainant's rights are of a trifling character ; if the injury which he would sustain from the act sought to be enjoined can be fully and easily compensated, while, on the other hand, the defendant would suffer great damage, and especially if the public would suffer a large inconvenience if the contemplated act was restrained, the lesser right must yield to the larger benefit ; the injunction should be refused and the complainant remitted to his action for damages. This rule has been enforced in a multitude of cases and under a variety of circumstances, and is one of such evident justice as needs no citation of authorities for its support.

\* \* \* \* \*

"FOURTH: In applying the rule first stated to a case like the one at bar, the Court should have due regard to other matters.

"(1) The amount of injury to the complainant \* \* \*

"(2) The Court will consider the solvency of the defendant."

In *N. Y. Grape Sugar Co. vs. American Grape Sugar Co.*, 10 F. R., 835, Judge WALLACE refused an injunction.



One of the first grounds assigned was the destruction of capital that would ensue and the injury to the workmen employed in the business. His Honor said :

"The defendants have gradually created and developed an extensive market for glucose and grape sugar ; so large that if their works were stopped the demand could not be well supplied, and serious inconvenience would result. They have not only invested a large capital in their manufacturing business, but they employ a great number of workmen, many of whom would be temporarily cut adrift if an injunction were granted. It is difficult to see how the defendants could remove the patented apparatus without substantially dismantling and reorganizing their works. Under such circumstances the equitable considerations which appeal to the discretion of the Court, and within well-recognized rules should lead to the refusal of a preliminary injunction, cannot be ignored."

In *Ballard vs. The City of Pittsburg*, 12 F. R., 783, and *Bliss vs City of Brooklyn*, 4 Fish., 596, the public safety and convenience was the consideration which induced the Court to refuse an injunction even after a final hearing.

See, also,

*McCrary vs. Penn. Canal Co.*, 5 F. R., 367.  
*Hoe vs. Boston Advertiser Co.*, 14 F. R., 914.

*Sanders vs. Logan*, 2 Fish., 167.

*Light Co. vs. Light Co.*, 45 F. R., 893.

*Parker vs. Sears*, 1 Fish., 93.

*Forbush vs. Bradford*, 1 Fish., 317.

*Potter vs. Whitney*, 3 Fish., 77.

### 8. Defendants are amply responsible.

The affidavit of Mr. Tewksbury (D. Rec., p. 363, fol. 252) shows that the affidavit of Edward D. Easton as to the irresponsible condition of the defendants, is untrue, and that, on the contrary, the United States Phonograph Company is entirely responsible and solvent ; that it owns its own plant, is without



debt, and is fully able to respond in damages to any judgment which may be obtained in this suit. Its stockholders are financially responsible men. It is a strong and active company, with a large plant, and doing the largest business of its kind in the world.

The complainant's brief upon this point is very misleading, for it states that the defendant company was organized with a "maximum permissible capital stock of \$3,000, and began business with an alleged capital of \$1,000."

The question is not how humble the origin of the defendant company was, nor with what limited capital it began business. The fact of the matter is that in January, 1894 (D. Rec., p. 55, fol. 220), the company was reorganized with an increased capital. This is the time when Mr. Tewksbury, who is a man of undoubted financial strength, became connected with the concern.

We call attention to the inconsistency in the complainant's position as to the defendant's responsibility as shown in Mr. Tewksbury's affidavit (D. Rec., p. 64, fol. 254).

It is well settled that the ability of a defendant to respond in damages to any judgment which may be obtained against it, is a ground for denying a motion for preliminary injunction.

Kane vs. Huggins, 44 Fed. Rep., 292.

Johnson vs. Aldrich, 40 Fed. Rep., 675.

Pullman vs. B. & O. R. R. Co., 5 Fed. Rep., 70.

### Other Defenses Discussed.

There are many other propositions of law and fact bearing upon the equities herein which it will probably be unnecessary to more than notice. Among these we may mention the reluctance on the part of a court of equity to interfere by preliminary injunction where the defendant is carrying on his business in good faith and has an established plant in operation which would be rendered useless by such writ. Thus *Hugh on Injunctions*, Section 960, says:



"Where a defendant is acting in good faith under letters patent covering his process of manufacture, he has a *prima facie* right to continue, and a court will not, upon *ex parte* affidavits on an application for preliminary injunction, decide the whole merits of a *bona fide* issue and thus anticipate a final judgment upon the legal questions involved."

Again, at Section 964, we find the following:

"And while the fact that defendants are using a machine which is openly made, sold and used under patents, and which the manufacturers have put upon the market in good faith and in open competition with the machines made by plaintiff, and in the belief that they were not trespassing upon his rights, will not of itself constitute a sufficient defense if defendants are adjudged guilty of an infringement upon the final hearing, it constitutes a reason why the Court should hesitate to interfere before final decree when there is no suggestion of irremediable injury in the meantime, or of any want of ability to respond in the event of a final recovery."

In *Consolidated Roller Mill Co. vs. Richmond City Mill Works*, 40 F. R., 475 (1889), a motion was made for preliminary injunction. The patent in suit had not, as in the present case, been adjudicated. The question of validity of the patent was pending in another suit, in which an appeal had been taken to the Supreme Court. The Court, in denying the motion, said:

"The defendant is a manufacturer, and the complainants are not, and if the Supreme Court should hold the Gray Patent invalid and reverse the decree of the Michigan suit, this defendant might, and probably would, suffer irreparable injury, while, if the decree of the Michigan Court is affirmed, the complainant can recover full damages and profits for the use of their patent and improvement. The defendant owns and operates an expensive establishment, and has a large capital invested in the manufacturing of rolling mills. *It cannot be said, upon the proofs before the Court, that the defendant has not been carrying on its business in good faith, and in a belief that it was not trespassing on the rights of others, and the sudden stoppage of its business might be ruinous to it.*"



We have heretofore shown that the defendants' operations are carried on under authority of both the Edison and the graphophone patents, and that the patents in suit, certainly so far as they concern the features here in issue, are anticipated not only by Mr. Edison's early operations, but also by the prior patent of Reynolds and the work of Lambrigot, Cros and Carbonel. This brings the case directly under a long line of authorities which hold that if, on the hearing of a motion for preliminary injunction, it appears that the validity of the patent is doubtful, or that the defendant is manufacturing under authority of its own patents and has therefore a *prima facie* right so to do, that there has been limited, if any, acquiescence in complainant's operations, or that defendant's infringement of the patent in suit is seriously assailed, and all doubt is not cleared up by the complainant, the relief must be denied.

Again, it has been repeatedly held that the Court will not dig and delve into the law and facts presented upon such a proceeding and exhaustively consider them for the purpose of determining whether or not the complainant is entitled to the writ. On the contrary, unless complainant's right be clear and convincing, and no doubt is left in the mind of the Court, the writ will be denied.

*Hurlburt vs. Carter, (supra).*

Complainants' patent had not been sustained. The defendant showed that it was manufacturing under a reissued patent owned by it, and claimed that the patent in suit was invalidated by a prior patent. Judge COXE said :

"The defendant insists that its copying books are manufactured under a reissued patent owned by it, and that the complainant's patent is invalidated by the prior patent granted to John R. Carter. *These defenses necessarily involve a careful analysis of the patents* referred to, and a determination as to the validity of the issue. Although they do not, as now present, offer a formidable barrier to the complainants' recov-



ery, yet in the light of the final hearing they may perhaps assume a different aspect."

See also

*Gold & Stock Tel. Co. vs. Commercial Tel. Co.*, 22 F. R., 839 (1885).

In this case a motion was made for a preliminary injunction. It was heard by Judge SHIPMAN, who denied the motion, saying :

"Assuming that the whole testimony is before the Court, and that it has been completely presented and can be carefully studied on this motion, the fact still remains that a temporary injunction is being sought upon a question which now arises for the first time, and which must be examined with the care and patience necessarily incident to a case wherein men's minds must differ. *In other words, the attempt is made to make a motion for a temporary injunction applicable to a state of facts to which such a motion is not adapted.* It is no answer to the argument that upon a motion for an injunction *pendente lite*, the question must be susceptible of ready answer, and the case must be free from reasonable doubt, to say that this whole case is now before the Court, and that the questions, after the state of the art is ascertained, are those of law which can be settled as well now as at final hearing ; because a motion for a temporary injunction is not designed for the adjudication of doubtful questions which have not previously been discussed."

As to the extent to which the complainant must go in showing validity of a patent as against anticipation, see *Fish vs. Domestic Sewing Machine Company*, 12 F. R., 496.

In *Steam Gauge & Lantern Co. vs. Miller*, 8 F. R., 320 (1881), Judge SHIPMAN said :

"Upon a motion for preliminary injunction the plaintiffs must establish the point of infringement *beyond a reasonable doubt*, and as this question often depends upon a proper construction of the patent, its claims should have ordinarily been construed by a Court of competent jurisdiction, or should have been practically construed by the consent and acquiescence of that part of the public which is cognizant of the extent of the monopoly."



Again, the attention of the Court is called to the fact that there is absolutely no showing on complainant's part that if there has been any acquiescence at all in these patents, that acquiescence has been in respect of the patents in suit. On the contrary, the sole ground in complainant's case for the contention of acquiescence is the license to Lippincott in 1888, and the sale of the corresponding British patents, and in each case several patents granted on the graphophone were involved. This is wholly insufficient to show acquiescence in the two particular patents which are now sued on.

A case directly in point is that of *Upton vs. Wayland*, 36 F. R., 691. This was a motion for a preliminary injunction upon one of the patents under which the Rochester lamp was manufactured. There had been no previous adjudication upon this particular patent, and it was shown that the lamp which the public recognized the sole right to the complainant to make was covered by *several patents*. Judge WALLACE denied the motion, on the ground that acquiescence had not been shown, saying:

"These lamps have been extensively dealt in by jobbers and used by the public *with acquiescence in the exclusive right of the owners of the patents*. But this is not cogent evidence of recognition of the novelty or value of the wick raiser or the validity of the patent therefor. *Non constat*, that recognition is not due to the other patented improvements. The motion is denied."

### **Complainant's Brief and Authorities.**

A perusal of the brief filed at the argument by complainant's counsel discloses that it was written with a one-sided view of the case, and as if nothing could be said in opposition to that view.

Starting out, as it did, to claim for both of the patents in suit a high standing in the art and an infringement thereof by the defendants, it is a significant and notable commentary on that brief that the *argument*



limited the complainant's contention down to the second of the two patents in suit, which involved the use of the phonograph blank, and conceded the right in the defendants to use the machines originally claimed to be covered by the first patent.

Thus the complainant's brief at the outset has been deprived of authority, and its exaggerated claims shown to follow from a hasty and inconsiderate treatment of alleged facts, which, when examined, are shown to lack foundation.

As to complainant's authorities. It relies apparently upon two cases, namely, *Blount vs. Société Anonyme*, 53 F. R., 98, and *Thomson Co. vs. Two Rivers Co.*, 63 F. R., 120.

A very superficial reading of the decision in the former suit shows that that case was strongest where the present case is weakest. In the first place, there had been a previous adjudication; and, secondly, the Court says: "It distinctly appears in the present case that the Chamberland Patent has, since its issuance in February, 1886, down to 1892, only been used under license or right granted by the patentee, and that during said period there has been a general public acquiescence in its validity."

Again, there was in the Blount case no question as to complainant's title. This is borne out by the statement (p. 102):

"It is not questioned that the complainants together are vested with the right, title and interest in and to the letters patent in suit, which were possessed by the patentee Charles E. Chamberland. Their title is fully established, if not conceded."

This also constitutes a wide difference from the present case, where the title of the complainant is most seriously disputed, and that dispute is one which cannot be reasonably and fairly settled until there is before the Court all of the multitude of agreements and licenses, together with the evidence of persons connected therewith. The Blount case cannot be regarded as an authority for the proposition



which complainant bases upon it, that it is sufficient to ascertain what are the "fair and reasonable probabilities." On the contrary, all of the facts in the case were discussed by the Court, and the conclusion arrived at was drawn principally from a conclusive showing of title in complainant, and validity and infringement of the patent, which are totally lacking in the case at bar.

The suit of *Thomson Co. vs. Two Rivers Co.* is another case which is strongest where complainant's case is weakest. Thus, it is stated in the decision:

"The infringement is unquestioned, and upon the conceded facts is deliberate and flagrant if the patents are valid."

Again, there was no denial that the patents "were of great utility; that the alleged new art and apparatus were received and recognized by the world at large and by electricians and scientists as novel and important, and the process immediately entered into wide use."

Neither was there a denial that the manufacturers had acquiesced in the validity of the patents. It further appeared that there were no contestants other than the defendants. There was not, in this case, a single one of the many issues presented in the case at bar. Thus, the infringement is decidedly disputed. There is no concession that it is deliberate and flagrant, and it is most strenuously denied that the patents are of any utility; that the apparatus of complainant was received and recognized by any one; and it is just as strenuously disputed that the alleged inventions are novel and important.

Again, complainant's showing of acquiescence has, we think, been completely broken down. These facts alone are sufficient to differentiate the suit at bar from the Thomson case upon which complainant apparently relies.

Again, complainant says that at the time defendant came into existence, the complainant had begun suits against its only competitor, and these suits were being



pressed with all "possible activity." Would it not have been an activity quite possible to apply for the relief against that defendant which has been asked for here, and has the complainant satisfactorily explained why such relief was not prayed for there nearly two years ago?

In conclusion, complainant's brief states that there is "no dispute" on the question of infringement, and that the writ should issue because the defendants have "acknowledged" that they could not lawfully operate without complainant's license. This is entirely without foundation in fact, as we have shown.

## CONCLUSION.

### I.

THE PATENTS IN SUIT STAND UPON AN EXCEEDINGLY NARROW FOUNDATION SO FAR AS THEIR NOVELTY IS CONCERNED.

(a) The earlier Graphophone Patent, so far as the claims which are quoted in Easton's affidavit are concerned, with the exception, perhaps, of the ninth, are anticipated by the Reynolds Patent, which employed a solid body in which the record was formed by cutting. The only novelty in these claims which remains over Reynolds is that in Reynolds the solid body was moved against the cutter, while in said claims the cutter is advanced against the solid body.

But in view of Edison's earlier work and patents, wherein the sound vibrations were used not only to produce the record directly, but also to control a more energetic force which did the work, the novelty which remains over Reynolds is found in Edison's Patent.

Further, Edison's Patents, as well as publications by others, show that it was old not only to advance the cutting tool to a blank, but that it was old to advance